

## **REMARKS**

Claims 1, 47 and 57 have been amended. Claims 10-33, 36-39, 48-50, 53-56, 65-88, 91-94 and 102-111 have been cancelled without prejudice. Claims 43-45, 51-52 and 98-100 have been withdrawn. Accordingly, claims 1-9, 34-35, 40-42, 46-47, 57-64, 89-90, 95-97, and 101 remain pending.

Claims 1, 47 and 57 were objected to for typographical errors, which have been corrected herein. Claims 43-45, 51, 52 and 98-100 were objected to because they had incorrect identifiers, which have been corrected herein.

The Examiner rejected claim 46 under 35 USC 112, second paragraph. The Office Action indicated that there was allegedly insufficient antecedent basis for the limitation, “determining the properties P1 and P2.” (Emphasis added.) Applicants respectfully request that the rejection be withdrawn, because the claim from which claim 46 depends, claim 3, properly recites “a property P1 of the difference spectrum D1 and a property P2 of the difference spectrum D2.” (Emphasis added.)

The Examiner rejected claims 58, 59 and 101 under 35 USC 112, second paragraph and 35 USC 101. The Office Action supported its rejection by indicating that claims 58, 59 and 101 are allegedly “directed to neither a ‘process’ nor a ‘machine,’ but rather embrace or overlap two different statutory classes of invention...” The Office Action also indicated that claims 58 and 101 allegedly “[claim] both determination steps and the apparatus limitations of claim 57.”

Claims 58, 59 and 101, however, do not claim steps of a method, but rather properly limit apparatus claim 57. Independent claim 57 recites the claim element, “a processor operable for determining any overlay error...” (Emphasis added.) Dependent claim 58 recites “[t]he system of claim 57, wherein determining any overlay error comprises...” (Emphasis added.) In other words, claim 58 modifies what the processor in claim 57 is operable for. Claims 59 and 101 depend from claims 58 and 59 respectively. Since claims 58, 59 and 101 properly limit the subject matter of a previous claim, applicants respectfully request that the rejection of claims 58, 59 and 101 under 35 USC 101 and 35 USC 112 be withdrawn.

The Examiner rejected claims 1-9, 32, 33, 40-42, 46, 57-64, 87, 88, 95, 96, 97 and 101, including independent claims 1 and 57, under 35 USC 103(a) as being unpatentable over the combination of U.S. 6,982,793 by Yang et al., U.S. Application 2002/0093648 by Nikoonahad et al. and U.S. 6,713,753 by Rovira et al. The Examiner rejected independent claim 47 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Yang and U.S. 5,805,290 by

Ausschnitt et al. The Examiner has deemed claims 34-35, 48 and 89-90 to be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Toward this end, independent claims 1, 47 and 57 have been amended to incorporate the limitations of claims 34-35, 48 and 89-90, respectively, in an alternative form. It is believed that claims 1, 47 and 57 are patentable over the cited art for the same reasons cited by the Examiner with respect to allowable claims 34-35, 48 and 89-90. Applicants thank the Examiner for identifying allowable claims.

Applicants believe that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Additionally, it is submitted that the withdrawn claims should be reinstated and allowed since each withdrawn claim depends from an allowed generic claim. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,  
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